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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/674,333

09/30/2003

Scott Ciarrocca

GYN5003

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27777

7590

10/03/2006

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EXAMINER

PEFFLEY, MICHAEL F

ART UNIT

PAPER NUMBER

3739

DATE MAILED: 10/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/674,333

Applicant(s)

CIARROCCA, SCOTT

Examiner

Michael Peffley

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 September 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 13-19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 and 20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Election/Restrictions

Claims 13-19 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on September 18, 2006.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 11 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 11 lacks proper antecedent basis for "the plurality of active electrodes". It appears claims 11 should depend from claim 10, which provides the necessary antecedent basis, and not from claim 1 as currently written.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

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only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 4-6 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Wrublewski et al (6,193,715).

Wrublewski et al disclose an endoscopic morcellator that includes an elongate shaft (204) having proximal and distal ends and a lumen therethrough, and a handle (202) coupled to the proximal end. An active electrode (208) is disposed about a periphery of the distal end, and a return electrode (i.e. inner member) is disposed within the shaft and is electrically insulated from the active electrode (208) via insulating member (215). A conduit extends through the shaft and has an outlet at the distal opening of the shaft. It is noted that the Wrublewski et al conduit is used primarily for suction, but is nevertheless a "fluid conduit" within the meaning of the claims. Figures 3 and 3A show the periphery of the shaft as being substantially circular (i.e. oval), and a source of RF energy is connected to the electrodes via connector (222). The examiner maintains the source is inherently capable of providing sufficient energy to create vapor pockets.

Claims 1, 4-6 and 10-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Hooven (5,957,884).

Hooven discloses an endoscopic morcellator that includes a shaft (18) having proximal and distal ends and a handle (16) attached to the proximal end. A lumen extends through the shaft, and one or more active electrodes are provided about a periphery of the distal end. The active electrode may be a ring (36) as shown in Figure

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5b, or there may be a plurality of active and return electrodes (74,75,76,77) disposed about the periphery in an alternating sequence as shown in Figure 6d. The examiner maintains the lumen through the shaft is a "fluid lumen", and that the energy source is inherently capable of providing sufficient energy to create vapor pockets on a surface of the electrode.

Claims 1, 3-6, 8, 10-12 and 20 are rejected under 35 U.S.C. 102(e) as being anticipated by West et al (2003/0055421).

West et al disclose a tissue morcellator that includes a shaft (30) that has a lumen extending therethrough and a handle (28) at the proximal end of the shaft. A plurality of active electrodes (66) are disposed about the periphery of a distal end of the shaft (Figure 4). West et al discloses that the electrodes may alternate active and return electrodes to operate in a bipolar manner (see para. 0058). West et al also disclose a plurality of fluid lumens (82) that extend through the shaft and into each individual spline element (see para. 0084). The periphery of the distal end of the shaft (i.e. the cross section of the shaft) is circular and the RF source is inherently capable of creating vapor pockets on a surface of the electrode. The spline members serve to electrically isolate one electrode from the next, and the fluid lumens are connected to a fluid source to provide fluid to tissue.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over either Wrublewski et al ('715), Hooven ('884) or West et al ('421) in further view of the teaching of Saadat (5,899,915).

Wrublewski et al, Hooven and West et al all disclose an RF source for providing energy to the electrodes of the morcellator, but fail to specifically disclose the use of a footpedal to control the delivery of energy. The examiner maintains that it is very well known to use foot pedals to control the delivery of RF energy in medical systems. In particular, it is noted that applicant's specification notes on page 7 the known use of foot pedals in prior art systems. Saadat discloses another morcellator system that includes an RF energy delivery means, and further specifically teach that it is known to use a foot pedal (120 – Figure 12) to control the turning on and off of the energy.

To have provided any of the Wrublewski et al, Hooven or West et al devices with a foot pedal to control the delivery of RF energy to the electrodes would have been an obvious consideration for one of ordinary skill in the art, particularly in view of the teaching of Saadat.

Claims 2 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hooven ('884) in view of the teaching of Eggers et al (5,697,882).

The Hooven device has been previously addressed. Hooven discloses bipolar electrodes for morcellating tissue, and also disclose various arrangements for the

electrodes. However, Hooven fails to disclose a proximally located return electrode disposed about the shaft.

Eggers et al disclose another RF device for the treatment of tissue with bipolar energy. In particular, Eggers et al teach that it is known to provide the return electrode on the shaft member proximal to the active electrodes provided at the distal end of the shaft.

To have provided the Hooven device with a proximally located return electrode located on the shaft member for the return of energy in a bipolar system would have been an obvious design consideration for one of ordinary skill in the art in view of the teaching of Eggers et al.

Conclusion

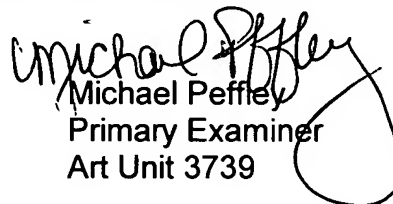
The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: 5,928,163; 6,997,926; 6,659,105; 6,032,673; 5,810,806; 6,565,561.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Peffley whose telephone number is (571) 272-4770. The examiner can normally be reached on Mon-Fri from 6am-3pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Michael Peffley
Primary Examiner
Art Unit 3739

mp
September 28, 2006